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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,796	12/09/1999	GREGORY MATHUS	5044	8079

7590

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EXAMINER

BEX, PATRICIA K

ART UNIT	PAPER NUMBER
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1743

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DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/457,796

Applicant(s)

MATHUS ET AL.

Examiner

P. Kathryn Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

## A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 11-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 December 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The cancellation of claims 1, 6-9 and the addition of claims 26-28 is acknowledged and has been entered into the record.

#### *Election/Restrictions*

2. Applicant's election of Group I, claims 1-15 in Paper No. 3a is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### *Drawings*

3. The corrected or substitute drawings were received on December 13, 2001. These drawings are approved by the Examiner.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "said tube receiving openings which include internal mutually spaced pads", does not reasonably provide enablement for "said tube receiving openings communicate with vertically disposed wells having open bottoms, wherein said wells are provided internally with mutually spaced support pads". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The specification does support wherein said *openings* 26-30 include internal mutually spaced pads 80-83, see page 7, 1<sup>st</sup> full paragraph, Fig. 7. There is

no mention of such openings being in communication with *vertically disposed wells* having open bottoms.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 26-28, 2-5, 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26, line 8, the recitation of "said openings" is confusing and indefinite, i.e. tube-receiving openings or downwardly-facing openings? Examiner has interpreted this to mean said downwardly-facing openings formed within the cover. Correction is required.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 26-28, 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) in view of Corsi *et al* (USP 4,942,271) or Aiken (USP 6,138,863).

Laska teaches a storage assembly for holding multiple test tubes 56, 59 of varying heights and diameters. The assembly comprising a base and a transparent cover portion. The base comprising a plurality of openings 25, wherein a plurality of projecting support pads 30 A-D, 60 A-D are symmetrically positioned within the openings. Moreover, the pads comprise a surface 31 A-D, 61 A-D which engages the test tubes (Figs. 1A- 6A). However, Laska does not disclose the use of a rotatable and removable cover comprising a notch, wherein the notch includes a trunnion travel surface and a ledge surface, or a base comprising a trunnion. Corsi *et al* do teach the use of a rotatable and removable cover. The cover comprising a notch, wherein the notch includes a trunnion travel surface 166, 260 and a ledge surface 162 and a base 114, 214 comprising a corresponding trunnion 120, 220. Additionally, Corsi *et al* do teach a latching means for securing the cover to the base (Figs. 1-13). Such a hinge system can be easily manufactured and does not require numerous parts.

Similarly, Aiken teach a multipurpose container having a cover and receptacle. The receptacle has a base, side and end walls. Additionally, the base comprises a plurality of slots or openings 110 therein. The container has a removable lid 120 with a notch 32 formed at the bottom surface of the lid. The notch including a surface which rotates around a trunnion 30, 36. The notch further comprising a ledge surface 40 (Figs. 4-8). Note: process limitations, i.e. the limitations describing the movement of the lid around the trunnion, have not been given any patentable weight, since process limitations are not accorded patentable weight in a claim which is directed to an apparatus.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the test tube storage assembly of Laska the hinge system, as taught by Corsi *et al* or Aiken, in order to provide a hinge system which can be easily manufactured and does not require numerous parts (column 1, lines 24-45, Corsi *et al*).

Regarding the shape of the openings, it would have been an obvious matter of design choice to have made the shape of the openings in the base of Laska rectangular. Moreover, since applicant has not disclosed that rectangular openings solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with circular openings. This same reasoning applies to the shape of the surface pads.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) and Corsi *et al* (USP 4,942,271) or Aiken (USP 6,138,863) as applied to claim 26, and further in view of Berry, Jr. (USP 5,415,846).

Laska, Corsi *et al*, and Aiken as discussed above, do not teach the specific use of slide latches to secure the cover to the base. Berry, Jr. does teach two slide latch mechanisms 49 designed for securing the lid 22 to the tray 21. The base comprising first and second base sidewalls 25, 26 each having a slide surface having a lengthwise groove 31 which mates with a lengthwise tongue 58 of the slide latch (Figs. 1-3, 6-7). Note: lengthwise has been interpreted to mean along the direction of length of the respective elements, wherein these elements not necessarily the same direction.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the system of Laska, Corsi *et al* and Aiken, the

securing mechanism of Berry, Jr. in order to provide a quiet smooth and convenient latch design (column 2, lines 30-34).

***Allowable Subject Matter***

12. Claims 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: see previous Office Action.

***Response to Arguments***

14. Applicant's arguments filed December 13, 2001 have been fully considered but they are not persuasive. In response to previous rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Aiken (USP 6,138,863), Applicant argues that vertical unimpeded movement of the cover is impossible in Aiken because the staggered fingers 32 resiliently engage opposite surfaces of the cylindrical member. However, this argument is not commensurate within the scope of the claims since such a feature is not currently recited within the instant claims. Claim 26 recites "unimpeded vertical movement of the cover into and out of said closed position", i.e. the cover can be rotated about said trunnions between its closed position and full open position. This is clearly not the same as "the cover being vertically raised from its closed position on said trunnions" as previously disclosed in original claim 1. Therefore, Examiner contends that Aiken does teach the unimpeded vertical movement of the cover into and out of said closed position. Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to *Corsi et al* (USP 4,942,271), Applicant argues that the joints are characterized by snap fits, which impede free separation of the interengaged components. Again, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., vertical unimpeded movement of the cover) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the movement of the cover is considered by Examiner an *intended* use, and if the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In all embodiments, *Corsi et al* teach a base and cover which are adapted to be releasably and pivotally coupled together to enclose conduits therein (column 2, lines 57-59).

### ***Conclusion***

15. No claims allowed.



16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

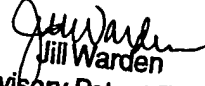
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays from 6:00 am to 3:30 pm EST.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

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